



533 Rec'd PCT/PTO

PATENT

P-1476-US

13 AUG 2001

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT(S): Michal Linial, Nathan Linial, Nafali Tishby and Golan Yona
SERIAL NO.: 09/601,278 PCT Legal Examiner: Bryan Tung/ Richard Cole
FILED: July 31, 2000 Group Art Unit:
FOR: AN AUTOMATIC METHOD OF CLASSIFYING MOLECULES

COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231
BOX: PCT (EO/US)
ATTN: PCT Legal Office

RECEIVED

16 AUG 2001

Legal Staff
International Division**A RENEWED PETITION UNDER 37 C.F.R. 1.47 (a)**

Dear Sir:

This Renewed Petition Under 37 C.F.R. 1.47(a) is filed in response to the Decision on Petition Under 37 C.F.R. 1.47(a) dated June 12, 2001 in connection with the above-identified Application. This Renewed Petition requests that the above identified application be accepted for United States national stage processing without the signature of one of the four joint inventors. A response to June 12, 2001 Decision must be filed August 12, 2001. Accordingly, this Renewed Petition is being timely filed.

In the Decision, the PCT Legal Examiner asserted that the Petition under 37 CFR 1.47(a) satisfied the requirements under 37 CFR 1.47(a) requesting i) an oath and declaration by each Applicant on his or her own behalf of the nonsigning joint inventors, iii) the fee set forth in 1.17; and iv) the last known address of the non signing inventors. However, the PCT Legal Examiner asserted that Applicants: i) have allegedly failed to present Golan Yona a copy of the complete application paper; and ii) have allegedly failed to provide factual proof that the missing joint inventor refuse to join in the application or cannot be reached after diligent effort.

In response, Applicants attached hereto a Supplemental Declaration in which Renee Ben Israel, Intellectual Property Manager of Yisum Research Development Company of the Hebrew University of Jerusalem states that she made numerous bona fide attempts to obtain the signature of Golan Yona on the Declaration and Power of Attorney through extensive correspondence through the e-mail in, a conference call November 6, 2000 and faxes in connection with the

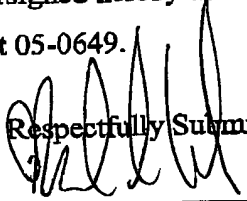
Applicant: Linial et al.
File No.: P-1476
Serial No.: 09/601,278
Page 2 of 2

subject Application and to settle the issues Golan Yona raised. Since it was evident Golan Yona has already a copy of the Application, the Oath and Declaration were sent to Yona by mail on November 14, 2000 and to his Patent legal counsel Meir Dahan, on February 17, 2001. These attempts were unsuccessful as Golan Yona, through his Patent Legal Counsel stated that he would sign the document only after the issue of the ownership has been resolved (Exhibit 5), thus refusing to sign the Declaration. Golan Yona was afforded in every opportunity to sign the Declaration, since of November 2000, from when he admitted he reviewed a copy of the PCT Application, through February 21, 2001, but refused to provide a signed copy of the Declaration and the Power of Attorney.

Thus, this Renewed Petition is in compliance with 37 CFR 1.47(a) and M.P.E.P Section 409.03. Therefore, Applicants hereby Petition under 37 C.F.R. 1.47(a) that the subject Application may be made by the other named joint applicants on behalf of themselves and the non-signing named joint applicant. Accordingly, Applicants request that the Patent Office grant this Petition and join the non-signing named joint inventor to the subject Application on filing the attached Oath or Declaration in compliance with 37 C.F.R. 1.63.

If any additional fee is due, the undersigned hereby authorizes the Patent and Trademark Office to charge such fee to Deposit Account 05-0649.

Respectfully Submitted,


Mark S. Cohen
Registration No. 42,425
Attorney for Applicants

August 12, 2001
Eitan, Pearl, Latzer & Cohen-Zedek
Crystal Park, Suite 210
2011 Crystal Drive
Arlington, VA 22202
Tel: (703) 486-1177
Fax: (703) 486-0800

SUPPLEMENTAL DECLARATION

I, Renee Ben-Israel, residing at 13/5 Hahayil Street., Jerusalem, Israel 97891, do hereby declare as follows:

1. I am employed in the Intellectual Property Department of the Yisum Research Development Company of The Hebrew University of Jerusalem having a mailing address of P.O.B. 4279, Jerusalem 91042 ("Yisum"). My position is Intellectual Property Manager.
2. I am responsible for the patent administration of all patents and patent applications filed in any jurisdictions through Yisum for The Hebrew University of Jerusalem. My duties include coordinating patent filing and prosecution such as acting as an intermediary between employees of The Hebrew University of Jerusalem who are named inventors on a patent application and the law firms prosecuting the specific patent application in order to obtain patent related documents necessary for filing or conducting prosecution in the United States Patent and Trademark Office and in other jurisdictions.
3. The subject application U.S 09/601,278 entered the United States National Stage (EO) under 35 U.S.C. 371 on July 31, 2000 and corresponds to PCT International Application No. PCT/IL99/00057, International Filing Date January 29, 1999 entitled "An Automatic Method Of Classifying Molecules", in the name of Yisum Research Development Company of The Hebrew University of Jerusalem as Applicant, and Natan Linial, Michal Linial, Naftali Tishby and Golan Yona as joint inventors for US only (the "subject Application"). The PCT Application claims the priority of U.S Provisional Application 60/072,977, filed on January 29, 1998.
4. On February 22, 2001, I submitted a Declaration in regard to the request that the subject application be accepted for processing without the signature of Golan Yona who is one of the named inventors, on the oath and declaration.
5. In response, the PCT Legal Office of the United States Patent and Trademark Office, issued a Decision and Petition, dated June 12, 2001, a copy of which is

attached hereto as Appendix 1, that according to the requirements under 37 CFR 1.47, applicants have submitted a Declaration by each Applicant on his or her own behalf and on behalf of the nonsigning inventors, Applicants have provided the requisite petition fee and the Petition states the last known address of the nonsigning inventor. However, the PCT Legal Officer concluded in the Decision that applicants have failed to i) demonstrate that a bona fide attempt was made to present a copy of the complete application paper to Golan Yona and ii) provide adequate proof on Yona's purported refusal to sign the application papers.

6. As I stated in the Declaration, I forwarded to the named inventors Natan Linial, Michal Linial, and Naftali Tishby, who were in Israel at the time, a copy of a Declaration and Power of Attorney requesting that they sign the Declaration and Power of Attorney in connection with the subject Application. On September 17, 2000, Natan Linial, Michal Linial, and Naftali Tishby signed and dated the Declaration and Power of Attorney. A copy of the Declaration signed by Natan Linial, Michal Linial, and Naftali Tishby is attached hereto as Exhibit 2.
7. Since I understood that Golan Yona was going to be in Israel in September 2000, I did not forward a copy of the subject Application and a copy of Declaration and Power of Attorney for his signature but rather waited until he arrived in Israel. When he did not arrive in Israel in September 2000, on October 3, 2000, I forwarded to Golan Yona by facsimile a copy of the Declaration and Power of Attorney requesting that he sign the Declaration and Power of Attorney in connection with the subject Application. A copy of the e-mail which was forwarded to Golan Yona requesting his signature on the Declaration and Power of Attorney in connection with the subject Application is attached hereto as Exhibit 3.
8. Since Golan Yona reviewed the subject Application as evidence of Yona e-mail dated November 2, 2000, a copy of which is attached hereto as Exhibit 4, I did not forward him a copy of the Subject Application. In the e-mail dated November 2, 2000 Golan Yona stated that "part f the text [of the Subject Application] is incorrect and I would have excluded it, had I seen the application before".

9. Further, attached here as Exhibit 6 is a letter dated December 27, 2000 from Meir Dahan who is patent legal counsel of Golan Yona further stating that Golan Yona has obtained a copy of the PCT and also has remarks on the Claims. In the letter (page 2) Meir Golan agreed that Golan Yona would sign the documents in connection with the Subject Application but subject to the condition that these documents will rightly and truly reflect the factual inventional and legal reality". In other words, he would not sign until Yissum agreed with his ownership interest which it does not. Further as admitted by Meir Dahan on behalf of his client, Golan Yona obtained a copy of the PCT Application which the Subject Application corresponds to.
10. In addition, in the Decision, the PCT Legal Officer asserted that "applicants have not provided adequate proof on Yona's purported refusal to sign the application papers". The Examiner asserted that "Ben-Israel's affidavit states that Ben Israel made numerous attempts to obtain Yona's signature on the declaration (see paragraph 10 of Ben Israel's affidavit), yet failed to provide any details regarding the alleged attempts".
11. In response, as I stated in the Declaration between November 2000 and December 2000, I made numerous attempts to obtain the signature of Golan Yona on the Declaration and Power of Attorney through extensive correspondence through the e-mail in, a conference call November 6, 2000 and faxes in connection with the subject Application and to settle the issues Golan Yona raised. The papers were sent to Yona by mail on November 14, 2000 and to his Patent legal counsel Meir Dahan, on February 17, 2001. It should be noted that Yona himself referred in the e-mail dated at about November 2, 2001 to "repeated claims by you and by Nati". These attempts were unsuccessful as Golan Yona never returned the Declaration and Power of Attorney signed but rather used the time to negotiate his ownership interest in the Patent Application.
12. Between October 2000 and February 2001, communications were also conducted through respective legal council of Yissum and Golan Yona regarding issues as to ownership of the rights in the PCT Application (Exhibit 7). Patent legal counsel for Golan Yona have been notified in a fax dated

February 19, 2001, that a response to the Notification was due (Exhibit 8) and also have not responded by providing a signed Declaration and Power of Attorney in view of the deadline (February 22, 2001). Moreover, I sent to the Patent legal counsel for Golan Yona a reminder on February 21, 2001 (attached hereto as Exhibit 9), and it was left unanswered.

13. Golan Yona was afforded in every opportunity to sign the Declaration, since of November 2000, from when he admitted he reviewed a copy of the PCT Application through February 21, 2001.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further, that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Renee Ben-Israel

August 12, 2001

Renee Ben-Israel
Intellectual Property Manager
Intellectual Property Department
Yissum Research Development Company
of the Hebrew University of Jerusalem
P.O.B. 4279, Jerusalem 91042

APPENDIX 1

JUN 12 2001



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
Washington, D.C. 20231
www.uspto.gov

Eitan, Pearl, Latzer & Cohen-Zedek
One Crystal Park, Suite 210
2011 Crystal Drive
Arlington, VA 22202-3709

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17 -06- 2001

EITAN, PEARL, LATZER & COHEN-ZEDEK

In re Application of LINIAL et al
U.S. Application No.: 09/601,278
Int. Application No.: PCT/IL99/00057
Int. Filing Date: 29 January 1999
Priority Date: 29 January 1998
Attorney Docket No.: P-1476-US
For: AN AUTOMATIC METHOD OF
CLASSIFYING MOLECULES

DECISION ON PETITION

UNDER 37 CFR 1.47(a)

This is in response to applicants' "Petition Under 37 C.F.R. 1.47(a)" filed 22 February 2001, requesting that the present application be accepted for United States national stage processing without the signature of one of the four joint inventors.

BACKGROUND

On 29 January 1999, applicants filed international application PCT/IL99/00057, which claimed priority of an earlier United States application filed 29 January 1998. A copy of the international application was communicated to the USPTO from the International Bureau on 05 August 1999. A Demand for international preliminary examination, in which the United States was elected, was filed on 13 August 1999, prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 31 July 2000 (29 July 2000 was a Saturday).

On 31 July 2000, applicants filed national stage papers in the United States. The submission was accompanied by, *inter alia*, authorization to charge the requisite basic national fee required by 35 U.S.C. 371(c)(1) and an unsigned declaration.

On 22 August 2000, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), indicating that an oath or declaration in compliance with 37 CFR 1.497 must be filed along with a surcharge under 37 CFR 1.492(e) for providing the oath or declaration later than thirty (30) months from the priority date.

Application No.: 09/601,278

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On 22 February 2001, applicants filed the present petition along with the appropriate extension of time fee. The petition states that it is accompanied by, *inter alia*: 1) a declaration signed by three of the four joint inventors and not signed by inventor Golan Yona; 2) an affidavit of Renee Ben-Israel, and 3) an authorization to charge the requisite petition fee.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by: (1) an oath or declaration by each applicant on his or her own behalf and on behalf of the nonsigning joint inventors, (2) factual proof that the missing joint inventors refuse to join in the application or cannot be reached after diligent effort, (3) the fee set forth in §1.17(i), and (4) the last known addresses of the nonsigning joint inventors.

With regard to item (1) above, applicants have submitted a declaration signed by three of the four joint inventors on their own behalf and on behalf of the nonsigning inventor Yona.

With regard to item (2) above, MPEP 409.03(d) states in relevant part,

Where a refusal to sign the application papers is alleged, the circumstances of this refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.

When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

In the present case, applicants have not demonstrated that a bona fide attempt was made to present a copy of the complete application papers (including specification, claims, drawings, and oath/declaration) to the nonsigning inventor Yona for signature. Although the affidavit of Renee Ben-Israel states that a copy of the declaration and power of attorney was sent via facsimile to Yona around 03 October 2000 (see paragraph 8 of Ben-Israel's affidavit), the affidavit

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-3-

does not establish that the specification, claims, and drawings were ever presented to Yona. Ben-Israel's affidavit states, "As is evident from the e-mail dated November 2, 2000, Golan Yona reviewed the PCT Application" (see paragraph 9 of Ben-Israel's affidavit). However, applicants have not provided an affidavit of the person having firsthand knowledge of the PCT application (including specification, claims, and drawings) being presented to Yona.

Furthermore, applicants have not provided adequate proof of Yona's purported refusal to sign the application papers. Ben-Israel's affidavit states that Ben-Israel made numerous attempts to obtain Yona's signature on the declaration (see paragraph 10 of Ben-Israel's affidavit), yet fails to provide any details regarding the alleged attempts. Thus, it would be inappropriate at the present time to conclude that Yona refuses to join in the application.

With regard to item (3) above, applicants have provided the requisite petition fee.

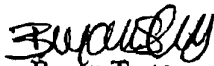
With regard to item (4) above, the petition states the last known address of the nonsigning inventor.

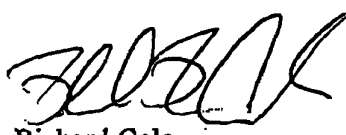
CONCLUSION

Because applicants have failed to satisfy item (2) above, the petition under 37 CFR 1.47(a) is DISMISSED without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Failure to timely file a proper response will result in abandonment of the application. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required.

Please direct further correspondence with respect to this matter to the Commissioner for Patents, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the PCT Legal Office.


Bryan Tung
PCT Legal Examiner
PCT Legal Office


Richard Cole
PCT Legal Examiner
PCT Legal Office

Telephone: 703-308-6614
Facsimile: 703-308-6459

APPENDIX 2

LAW OFFICE

Attorney Docket No.: P-1476-US

DECLARATION AND POWER OF ATTORNEY FOR PATENT APPLICATION

As a below named inventor, I hereby declare that:

My residence, post office address and citizenship are as stated below under my name.

I believe that I am the original, first and sole inventor of the subject matter which is claimed and for which a patent is sought on the invention entitled

AN AUTOMATIC METHOD OF CLASSIFYING MOLECULES

the Specification of which



is attached hereto

was filed on January 29, 1999

as Application Serial No. PCT/IL99/00057

and was amended on _____ (if applicable).

I hereby state that I have reviewed and understand the contents of the above-identified Specification, including the claims, as amended by any amendment referred to above.

I acknowledge the duty to disclose information which is material to the examination of this application in accordance with Title 37, Code of Federal Regulations, 1.56(a).

I hereby claim foreign priority benefits under Title 35, United States Code, 5119 of any provisional application filed in the United States in accordance with 35 U.S.C. §1.119(e), or any application for patent that has been converted to a Provisional Application within one (1) year of its filing date, or any foreign application(s) for patent or inventor's certificate listed below and have also identified below any foreign application for patent or inventor's certificate having a filing date before that of the application on which priority is claimed.

PRIOR FILED APPLICATION(S)

<u>APPLICATION NUMBER</u>	<u>COUNTRY</u>	<u>(DAY/MONTH/YEAR FILED)</u>	<u>PRIORITY CLAIMED</u>
60/072,977	US	29-Jan-98	YES
PCT/IL99/00057	PCT	29-Jan-99	YES

I hereby claim the benefit under Title 35, United States Code, §120 of any United States application listed below, and, insofar as the subject matter of each of the claims of this application is not disclosed in any prior United States application in the manner provided by the first paragraph of Title 35, United States Code, §112, I acknowledge the duty to disclose material information as defined in Title 37, Code of Federal Regulations, §1.56(a), which occurred between the filing date of the prior application and the national or PCT international filing date of this application:

-LAW OFFICE

Attorney Docket No.: P-1476-US

APPLICATION
NO.

PCT/IL99/00057

FILING DATE
(DAY/MONTH/YEAR)

29-Jan-99

STATUS - PATENTED,
PENDING, ABANDONED

I hereby appoint as my attorney(s) and agent(s) Heidi M. Brun (Agent, Registration No. 35,104), or Jerome R. Smith, Jr. (Attorney, Registration No. 35,684), or Daniel J. Swirsky (Agent, Registration No. 45, 148) or Mark S. Cohen (Attorney, Registration No. 42, 425) or Rachel L. Abboudi (Agent, Registration No. 44,490) or Suzanne Erez (Agent, Registration No. P-46,688) said attorney(s) and agent(s) with full power of substitution and revocation to prosecute this application and transact all business in the Patent and Trademark Office connected therewith.

Please address all correspondence regarding this application to:

EITAN, PEARL, LATZER, & COHEN-ZEDEK
ONE CRYSTAL PARK, SUITE 210
2011 CRYSTAL DRIVE
ARLINGTON, VA 22202-3709

Direct all telephone calls to (703) 486-0600 and all facsimiles at (703) 486-0800.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further, that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

FULL NAME OF INVENTOR: LINIAL, Michal

FULL RESIDENCE ADDRESS: 18 Neve Shaanan Street, Apt. 17,
Jerusalem 93707, Israel

COUNTRY OF CITIZENSHIP: Israel

FULL POST OFFICE ADDRESS: same

SIGNATURE OF INVENTOR

DATE

Sept 17, 2000

LATZER+COHEN-ZEDEK

Attorney Docket N : P-1476-US

FULL NAME OF INVENTOR: LINIAL, Nathan

FULL RESIDENCE ADDRESS: 18 Neve Shaanan Street, Apt. 17
Jerusalem 93707, Israel

COUNTRY OF CITIZENSHIP: Israel

FULL POST OFFICE ADDRESS: same

SIGNATURE OF INVENTOR Nathan LinialDATE Sept. 17, 2000

FULL NAME OF INVENTOR: TISHBY, Naftali

FULL RESIDENCE ADDRESS: 6 Hadishon Street, Jerusalem 96956, Israel

COUNTRY OF CITIZENSHIP: Israel

FULL POST OFFICE ADDRESS: same

SIGNATURE OF INVENTOR Naftali TishbyDATE Sept. 17, 2000

FULL NAME OF INVENTOR: YONA, Golan

FULL RESIDENCE ADDRESS: 3 Haraz Street, Rehovot 76310, Israel

COUNTRY OF CITIZENSHIP: Israel

FULL POST OFFICE ADDRESS: same

SIGNATURE OF INVENTOR _____

DATE _____

EXHIBIT 3

[Fwd: Patent status report and docs for signature re Protomap patent]

Subject: [Fwd: Patent status report and docs for signature re Protomap patent]
Date: Tue, 17 Oct 2000 13:30:16 +0200
From: Renee Ben-Israel <renee@yisum.co.il>
Organization: Yisum
To: Golan Yona <golan@gimmel.stanford.edu>

Dear Golan,

I tried calling you yesterday night but was told that you weren't in.
I'll try again later today.
Any news with the docs? If you have any question, please let me know.
Thank you.
Renee

--
Renee Ben-Israel
Intellectual Property Manager
Yisum Research Development Co.
of the Hebrew University of Jerusalem
POB 4279, Jerusalem 91042, IL
Tel: 972-2-563-4680(ext 204) Fax: 972-2-566-0331

Subject: Patent status report and docs for signature re Protomap patent
Date: Tue, 03 Oct 2000 12:20:05 +0200
From: Renee Ben-Israel <renee@yisum.co.il>
Organization: Yisum
To: Golan Yona <golan@gimmel.stanford.edu>
CC: "Linial Michal, Dr." <michal@leonardo.lis.huji.ac.il>,
"Linial Natan, Prof." <nati@cs.huji.ac.il>,
"Tishby Naftali, Prof." <tishby@cs.huji.ac.il>

Dear Golan,

Please accept my apologies for the tardiness of my letter, in fact I understood that you were supposed to be here before Rosh Hashana and therefore didn't send you any papers by mail. Now, I understand that you are scheduled to arrive this week but in order to expedite matters, I'll fax you the documents for your signature as well as the other requested papers.

The docs are the ones related to the US application, namely: Declaration and Power of Attorney and Assignment, please sign with blue ink beside your name, thank you. For your information and this may also be a good opportunity to update Michal, Nati and Taly too in a more detailed way, the patent status of this case is as follows:

Following the first Provisional application filed in January 1998 we have subsequently (January 1999) filed a PCT application designating "all countries". The PCT application was published in August 5, 1999, publication no. WO 99/39174 (a copy of the front page is attached in the fax). The countries designation, in fact, gives you, within 18 months from its filing, the possibility of choice among the "all countries" list, in which countries you really intend to have the patent valid. After long deliberations, we have finally settled for the USA, Europe and Japan considering that these are the most important markets for the technology. The expected actions now are Examination in each of the countries, separately, until the final allowance and granting of the same patents. In the US it may take around a year before we receive a first Office Action, in Europe a bit longer and in Japan we have 7 years before Examination unless we request an Expedite Process.

Apart from that I am attaching to the fax the Hamtsaat Sherut form provided by the inventors prior to the filing and the Horaot Manhala 15-001 as a reference, I think that these are the papers you requested.

Should you have any questions, please don't hesitate contacting me.

As for the other issues, I may send it to you in a separate letter, or let's discuss it when you're here.

Best regards and shana tova,

Renee

—
Renee Ben-Israel
Intellectual Property Manager
Yisum Research Development Co.
of the Hebrew University of Jerusalem
POB 4279, Jerusalem 91042, IL
Tel: 972-2-563-4880(ext 204) Fax: 972-2-566-0331

EXHIBIT 4

Re:

Subject: R :

Date: Tue, 14 Nov 2000 10:25:35 -0800 (PST)

From: Golan Yona <golan@gimmel.stanford.edu>

To: Renee Ben-Israel <renee@yissum.co.il>

Dear Noemi

Please send documents to that address.
Golan

Golan Yona

Department of Structural Biology
Stanford University
Fairchild Science Building D-109
Stanford, California 94305-5126
U.S.A

<http://csb.stanford.edu/golan/>Phone: (650) 725-0754 Fax: (650) 723-8464

On Tue, 14 Nov 2000, Renee Ben-Israel wrote:

> Dear Golan,
> Please let us have your mailing address, in order to send you a copy of a
letter
> concerning the prosecution of one of the patent applications.
> thank you
> Noemi Lerner
> Intellectual Property Yissum
>
> Golan Yona wrote:
>
> > Dear Renee
> >
> > We will call you either monday morning, or monday
> > afternoon, your time. There is no need for a conference
> > call yet. We would like just to clarify few issues.
> > When are you available at your office?
> >
> > Golan
> >
> > On Thu, 2 Nov 2000, Renee Ben-Israel wrote:
> >
> > > Dear Golan,
> > >
> > > I am sorry, I don't think this discussion is leading us anywhere. You
> > > certainly have the right to see the facts as you see them and all I can do
is
> > > to try and explain to you Yissum's procedures vis-a-vis inventors'
updating.
> > > When we decide to file an application we request a "tofes Hamtsaat Sherut"
> > > from the inventors where they disclose, among other details, their
invention,
> > > funding they may have received, the list of inventors and their
proportional
> > > rights, personal data as addresses, citizenship, etc. Since the request is
> > > usually done by one of the inventors and when all of them belong to the
same
> > > institution we typically correspond with one inventor only. When the
invention
> > > is developed by mor than one institution w correspond with the other
> > > institution, as well, we have an Inter Institutional agreement signed

Re:

between

> > > the parties, etc. Having all parties agreeable, we proceed with the filing.
> > > The usual procedure is to send it to a patent attorney to have it drafted
in

> > > the best possible way in order to provide us with the best and broadest
> > > possible patent protection.

> > > In the case of this file, since we started with a Provisional filing based
on

> > > a paper written by 4 persons of the HUJI this wasn't done, we sent the
paper

> > > to Eitan, Pearl, etc. and after receiving their ok, it was filed "as is" in
> > > the US PTO. At this stage you were my "contact person" but some time
> > > afterwards you left and I sent the correspondence to Nati.

> > > A year later, when we reached the end of the Provisional filing we had to
> > > decide on the next steps and since this was considered a good project and
we

> > > had received funding from the Horowitz fund (I believe you are acquainted
with

> > > this fact since I can see your signature in the Horowitz fund document
letter)

> > > we decided to file it in the PCT. At this point, we requested Eitan, Pearl,
> > > etc. office to draft the patent as usual (in the best and broadest possible

> > > way) and this is exactly what was done and what any sensible patent owner
> > > would have done. I have a Power of Attorney form signed by Yisum's CEO

and

> > > all the inventors (including yourself) in my file. A copy of the PCT
> > > publication was sent to Nati in September 1999.

> > > The next step was the National Phase (July 2000), here we had to decide in
> > > which countries we wanted to keep the application. There were long

> > > deliberations since we typically won't incur such expenses without a

> > > licensee's support, but we finally decided to file it in the US, Europe and
> > > Japan. The decision is Yisum's decision only since this is Yisum's

> > > proprietary know-how and the costs are borne by Yisum. We appreciate

> > > receiving inventors' feedback but the final decision is Yisum's one.

Should

> > > we decide to drop the entire portfolio it's our prerogative to do so. What
we

> > > usually do in these cases is to present the inventors the option of keeping
it

> > > at their own expense. Since this wasn't the case, you weren't offered this
> > > option.

> > > As I told you previously, you are certainly entitled to see the facts from
> > > your point of view, but from Yisum's standpoint this was a regular

procedure.

> > > We correspond with one inventor only assuming that the group works
together.

> > > Should you want to receive information from our office, you are welcome to
> > > request it.

> > > As for the US and European versions: I haven't yet received them from
Eitan,

> > > Pearl office but they are both based in the PCT version. I have the
Japanese

> > > translation if you are interested in it.

> > >

> > > I hope to have clarified the matter. Should you have any questions, please
> > > don't hesitate contacting me. I would also like to suggest a conference

call

> > > between you, Prof. Levitt, Rachel Bentov, Nati, Tali and me (Michal is away
at

> > > the moment) in order to overcome the problems. Please let me know what is a
> > > suitable time for you. Thank you.

> > >

> > > Sincerely

> > >

> > > Rense

> > >

> > >

> > >

Re:

> > >
> > > Golan Yona wrote:
> > >
> > > > Dear Renee
> > > >
> > > > I'm writing you this email in response to repeated claims by you and
> > > > Nati.
> > > >
> > > > It is true that we had a few phone conversations before I left HUJI but
> > > > our interaction was very limited. I'm puzzled by your/Nati's repeated
> > > > claims that I have seen the patent application before. The application
> > > > clearly uses text that I wrote only after I left HUJI. Moreover, part of
> > > > the text is incorrect and I would have excluded it, had I seen the
> > > > application before.
> > > >
> > > > I'm surprised that Nati, Michal, Tali and Yissum did not check
> > > > the facts before stating false claims. The FACTS are: (1) a draft of the
> > > > application was never handed to me. (2) the application uses text that I
> > > > wrote after I left HUJI. (3) this text was modified by somebody in a way
> > > > that would not have been approved by me.
> > > >
> > > > I think we should move on now.
> > > >
> > > > Sincerely,
> > > > Golan
> > > >
> > > > --
> > > > Renee Ben-Israel
> > > > Intellectual Property Manager
> > > > Yissum Research Development Co.
> > > > of the Hebrew University of Jerusalem
> > > > POB 4279, Jerusalem 91042, IL
> > > > Tel: 972-2-563-4880(ext 204) Fax: 972-2-566-0331
> > > >
> > > >
> > > >
> > > > --
> > > > Renee Ben-Israel
> > > > Intellectual Property Manager
> > > > Yissum Research Development Co.
> > > > of the Hebrew University of Jerusalem
> > > > POB 4279, Jerusalem 91042, IL
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> > > >
> > > >
> > > >

EXHIBIT 5

December 27, 2000

(b) Our client is the legal owner of 80% (eighty percents) in every patent or patent application that will be filed for the Invention or that was already filed for the Invention. For legal and factual arguments which will be brought in detail if necessary, the Hebrew University Regulations which states that for the purpose of ownership in inventions a postgraduates and Ph.D. students will be considered as an University employee, are not relevant in our client's case and do not bind him.

3. Rights in the Computer Programs

(a) Dr. Yona Golan also owns the substantial copyrights in the computer programs which are used for the implementation of the Invention, the use in the outcome of the subject method of the Invention and its representation in the Internet sites (hereinafter "**The Computer Programs**"). Such copyrights vests in Dr. Golan. *inter alia*, since he is the author and the creator of the Computer Programs.

(b) In fact, your use of the Computer Programs in your Internet sites constitute an infringement of our client's copyrights in the Computer Programs.

4. Signing documents in connection with the patent applications

(a) Our client has never received from you a formal copy of any patent application. Our client will be prepared to sign any documents which are required for the filing and/or the handling of patent applications in connection with the Invention, including a patent application that will be filed or has already been filed in the US, subject to the condition that these documents will rightly and truly reflect the factual, inventional and legal reality.

(b) Although you have never sent to my client any formal copy of the patent application, he obtained a copy of the PCT from the Internet. It should be noted that on primarily examination of the PCT it seems that the claims are exceeding the Invention.

5. You are therefore required to proceed as follows:

(a) To register our client as the owner of 80% (eighty percents) of every patent application that will be filed or has already been filed in connection with the Invention.

(b) To notify our client on every agreement and/or legal engagement and/or negotiation which you are handling in connection with the use and/or the commercialization and/or the exploitation of the Invention.

(c) In this stage our client agrees that you will continue to use, for academic use only, the Computer Programs in your Internet sites in which the ProtoMap technology is presented.

(d) To bear our client's expenses to enable him to devote the required time for studying the documents and the patent applications.

December 27, 2000

6. Bearing in mind the complexity of this issue, I hope that you will offer our client a serious and reasonable settlement offer to end the dispute by way of a settlement.

Sincerely yours,

Meir Golan, Adv.
Dr. Mark Friedman & Co.

cc: Dr. Golan Yona

\\ind\letters\170110

EXHIBIT 6

YEHUDA RAVEH & CO. - LAW OFFICES

יהודה דוה ושות' - משורר עורכי דין

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Sara Shalom
Yuval Grayevsky
Carmit Bar-On
Yehuda Glatt
Daniel Savitch
Uri Yamin
Myriam Abitbol
Jeremy Rosenshine
Jonathan Finklestone
Jonathan Leibler
Binna Ben-Sadeh
Gabriel Rubenbach
Liat Rakotch
Chagai Ullman
Michael Oster
Ronit Raboy
Sharon Elidan
Shelly Bakshi
Arieh Holzer
Daphna Fuchs
Muttan Ben Shaul
Nir Zanzuri
Sharon Florentin
Paul Landes
Yaron Szilas

Of Counsel:
Tamar Hausner-Raveh
Tamar Ben-David

המשרד בירושלים
Jerusalem Office
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 פקס: 5617101-02
 E-mail: lawfirm@yraveh.co.il

המשרד בתל-אביב Tel-Aviv Office
 טל: 5620303-03
 פקס: 5618558-03
 E-mail: raventlv@ravehtlv.co.il

יְהוּדָה רוּחַ
 לִיזָה טָרוֹס
 חַיִּים שְׁטָרֹן
 שָׂדֶה שְׁלוֹם
 וּבֶל גְּרִיבֶסְקִי
 כְּרָמֵיז בֶּר-אוֹן
 יְהוּדָה גֶּלֶט
 דִּנְהָל סֶאבִּיץ'
 אוֹרֵי יָמִין
 מָרִים אֲבִיטָבוֹל
 יִדְמִי רוֹזנְשְׁטֵין
 יוֹנָתָן פִּינְקֶלשְׁטֵין
 יוֹנָתָן לִיבֶלֶר
 בִּינָה בֶן-שָׂדֶה
 גְּבִרְיָאל רוֹנְבֵּלד
 לִיאָת רָקוֹטשׁ
 חָגִי אוֹלְמָן
 מִיכָאֵל אוֹסְטֶר
 רוֹנִית רֶבִי
 שָׁלוֹן אֶלְיָן
 שְׁלִי בֶקֶשׁ
 אֲרִיָּה חוֹלֶצֶר
 דְּפִנָּה חוֹמֶס
 מֵתָן בֶּן שָׁאוּל
 נִיר זִנְדוֹרִי
 שָׁלוֹן פֿלודֶנְטֵין
 פֹּל גֶלֶדֶס
 יִרֹן סִילֶשׁ

תמ"ר האונגרי-100
תמ"ר בן-100

Jerusalem, 08 January 2001

**Mr. Meir Dahan, Adv.
Dr. Mark Friedman & Co.
7 Haomanim St.
Tel -Aviv**

Without Prejudice

By registered mail and fax 03-5811333

Dear Mr. Dahan,

Re: Yona -Yissum

My client, Yissum, Research Development Company of the Hebrew University, conveyed to me your letter of December 27th and requested that I reply as follows.

1. Let me commence by stating that my client rejects the contents of your letter. My client is the legal owner of 100% of the Invention and the Computer Programs, as defined in your letter.
2. Dr. Yona was involved in the past, as an assistant researcher, in a project of the Hebrew University, led by three researchers (who are leading researchers

113542

NO. 557 P. 8/11

08/07/2007. Ser. 1-11. Gen. Court. 11:10 AM

YEHUDA RAVEN CO. - LAW OFFICES**יהודה רון ושות' - משרד עורכי דין**

2

26 Ushakim Street P.O.Box 7722, Jerusalem 91077
 35 Shaul Hamalech Blvd P.O.Box 33804 Tel Aviv 64927

רח' אוסישקין 26 ת.ד. 7722, ירושלים 91077
 שדרות שאול המלך 35, ת.ד. 33804, תל-אביב 64927

in their field) in developing the Protomap Technology which is the basis for the Invention. Thereafter, a patent application in respect of the Invention was filed in the name of my client.

3. All research leading to the Invention, as well as the scientific and academic developments underlying it, were carried out at the Hebrew University and funded thereby. The three head researchers and Dr. Yona were all, at the time, employees of the Hebrew University. The result of the above is that all inventions stemming from the research are owned by my client subject to University rules and regulations. Furthermore, all the researchers, including Dr. Yona, signed a written statement declaring the Invention a "Service Invention," the result of which is fully clear to you.
4. We of course reject your client's contention that he is the legal owner of 80%!! of any patent relating to the Invention or that he has any rights at all in the Invention, though, the lead researchers agreed to grant your client 25% of any rights which are granted to the "inventor's", under the Hebrew University regulations.
5. My client was in touch with Dr. Yona however they failed to reach an amicable understanding despite their efforts and good intentions. In light of the above your client is hereby required to cease all and any commercial or other use of the Invention and the Computer Programs and to terminate operation of the web site both at Cornell University and at Stanford University, which are violating my client's rights.

Your early response to this letter would be appreciated.

Best regards,

Yehuda Glatt

Cc: Yisum

EXHIBIT 7

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Jonathan Leibler
Bina Ben-Sadeh
Gabriel Rubenbach
Liat Rakotch
Chagai Ullman
Michael Oster
Raphael Raboy
Sharon Elidan
Shelly Bakshi
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Daphna Fuchs
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Yaron Szilas
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יהודה רבה
ליזה טרוס
חיים שטרן
סרה שלום
יובלי גרייבסקי
כרמית בר-און
יהודה גל
דניאל סאביץ'
אורי ימין
מרים אביטבול
ירמי רוזנשין
יונתן פינקלשטיין
יונתן ליבלר
בינה בן-סדה
גבריאל רובנבך
ליאת רקוטש
חגי אולמן
מיכאל אוסטר
יונית רבוי
שרון אלידן
שלי בקשי
אריה הולצר
דפנה פוקס
מיתן בן שאול
ניר זנזורי
שרון פלורנטיין
פול לונדס
ירון סילס
תמר האוזנר-רבה
תמר בן-דוד

Jerusalem, 19 February 2001

To: Mr. Meir Dahan

By Fax: 03-5611333
03-5625554

From: Yehuda Glatt

Re: Golan-Yissum-Reminder

Dear Mr. Dahan,

I have not heard from you in respect of my previous fax of 16.2.01.

It is of utmost importance that your client signs the forms, which are required for registration of the patent in the U.S. As I explained in my letter, the last date for submission is 22.2.01 therefore your client's urgent response is required. Let me stress that your client's delay will cause my client substantial damage.

I am attaching, once again, my above mentioned letter.

Best regards,

Yehuda Glatt

CC: Renee Ben-Israel - Yissum

115286

EXHIBIT 8



**Yissum R search Dev lopment Company
of The Hebrew University of Jerusalem**

Intellectual Property Department

POB 4279, Jerusalem 91042

Tel: 972-2-563-4880 (ext 204 or 212) Fax: 972-2-566-0331

e-mail: renee@yissum.co.il or noemi@yissum.co.il

FACSIMILE COVER SHEET

DATE: 21 Feb 2001

FACSIMILE NUMBER: 03-562-5554

TO: Adv. Meir Dahan

COMPANY: Dr. Mark Friedman Ltd.

FROM: Renee Ben-Israel

No. of pages (including cover): 3

If you do not receive all the pages, please inform us promptly.

Message:

2nd. Reminder!
Dear Mr. Dahan,
Please note that the absolute
deadline for filing the document
is tomorrow Feb 22, 2001.
Sincerely
Renee Ben-Israel